

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD H. JUNGSMANN, KEN R. JORDAN and BERNHARD PALM

Appeal No. 1998-1642
Application No. 08/541,894

ON BRIEF

Before McQUADE, CRAWFORD, JENNIFER D. BAHR, Administrative
Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 24 through 28, 30, 32 through 35, 37, 39 and 41. Claims 1 through 23, 29, 36 and 38 have been canceled. Claims 31 and 40 are allowable if rewritten in independent form.

The appellants' invention relates to a reciprocating saw. An understanding of the invention can be derived from a reading of exemplary claim 24, which appears in the appendix to the appellants' brief.

The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Hoffman	3,750,283	Aug. 7, 1973
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The rejection

Claims 24 through 28, 30, 32 through 35, 37, 39 and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hoffman.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 14, mailed October 27, 1997) for the examiner's reasoning in support of the rejection and to the appellants' reply brief

¹ This rejection was entered as a new rejection in the Examiner's Answer. The examiner's rejection based on the Dillon reference has been withdrawn. (See Letter from the examiner, Paper No. 17).

(Paper No. 16, filed December 15, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection in this case is under 35 U.S.C. § 102(b). We initially note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789

(Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In the instant case the examiner finds that the Hoffman reference as depicted in Figures 8a-8c discloses the invention as claimed (See examiner's answer at page 6). In regard to the recitation in claim 24 that the blade is held under tension between first and second members, it is the examiner's opinion that this language refers to functional language which is not entitled to patentable weight and if the language is entitled to weight, the blade depicted in Hoffman Figures 8a-8c is inherently held under tension as claimed.

We do not agree with the examiner that the functional language in claim 24 is not entitled to patentable weight. We must, and we will give weight to all claim limitations including functional language. In re Angstadt, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976).

As a preliminary matter, we find it necessary to interpret the term "tension" which appears in the functional

clause of claim 24. We have reviewed the specification and note that the specification does not specifically define "tension." Tension is defined in the dictionary as the state of being stretched. Webster's II New Riverside University Dictionary, The Riverside University Publishing Company (1984). The specification states that the blade shoulders 68 and 69 of the blade are forced against ears 45 and 46 and that the blade is urged inwardly because the engaging member 56 is forced against the back of hole 66 (See specification at page 6). This engagement of the blade would result in stretching or tension on the blade.

In regard to the examiner's finding of inherency, it is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746,

1749 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Hoffman discloses a blade, depicted in Figures 8a-8c which is held between balls 218, 222 and 224. Hoffman does not disclose any force exerted by balls 218, 222 and 224 which would result in the blade being held under tension. Hoffman discloses that sleeve 208 itself confines the blade against any movement in the plane of the slot (Col. 8, lines 19 through 26). While it is true that there may be a certain amount of bending and thereby stretching of the blade, depending on how the balls engage the recesses, the examiner has not advanced a rationale which would establish that this will necessarily be the case. We note that inherency can not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Continental at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

In view of the foregoing, we are of the opinion that the examiner has not established a prima facie case of anticipation based on inherency. As such, we will not sustain

the examiner's rejection as it is directed to claim 24 and claims 25 through 28, 30, and 32 dependent therefrom. We will also not sustain the examiner's rejection of claim 35 as this claim also recites that the blade is held under tension.

The examiner entered a new rejection of all claims in the Examiner's Answer. The appellants have not argued the patentability of independent claim 33 and claims 34, 37 and 39 dependant therefrom in the Reply Brief. The appellants' arguments are directed to the Dillon reference, rather than Hoffman on which this rejection is based. Therefore, we are constrained to affirm the rejection as it is directed to claims 33, 34, 37 and 39.

Appellants argue that Hoffman does not disclose that the saw blade is pulled tight against the first member. The specification does not include a definition for "pull." However, Webster's II New Riverside University Dictionary, The Riverside University Publishing Company (1984) defines the verb "to pull" as "to apply force to so as to cause or tend to cause motion toward the source of the force." Hoffman discloses and depicts in Figures 8a and 8b that the balls 218,

222 and 224 are cammed inwardly with respect to slot 202 so that the members 218, 222 and 224 enter respective recesses of the blade and hold the same against movement out of the slot. (Col. 8, lines 19 to 22). However, Hoffman does not disclose that a force is exerted by the balls on the blade which causes the blade to move toward any of the balls. As such, it is our view that the blade is not pulled tight against the first member 218 or 220 and 222 as recited in claim 41.

In addition, as depicted in 7a and 7b, Hoffman discloses that the blade is held at hole 192 by pin 178 and that ball 188 frictionally engages the blade. While the ball 158 and pin 178 may cause the blade to move toward the ball 158 or pin 178, the examiner has not established that this is necessarily the outcome of the actions of ball 158 and pin 178.

In view of the foregoing, we will not sustain the examiner's rejection of claim 41.

In summary, the examiner's rejection as it is directed to claims 24 through 28, 30, 32, 35 and 41 is not sustained. The

examiner's rejection as it is directed to claims 33, 34, 37,
and 39 is sustained.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

	JOHN P. McQUADE)	
	Administrative Patent Judge)	
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	MURRIEL E. CRAWFORD)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
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	JENNIFER D. BAHR)	
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